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Docket: 202462US-2

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

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Re: Group Art Unit: 2876
Serial No.: 09/769,510
Filed: JANUARY 26, 2001
Applicant: TOMOHIRO NAKAJIMA, ET AL.
For: OPTICAL SCAN MODULE, OPTICAL SCANNER,
OPTICAL SCAN METHOD, IMAGE...

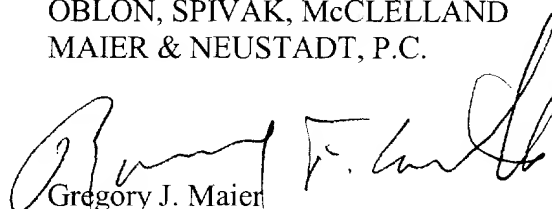
Attached hereto for filing are the following papers:

RESPONSE TO AN ELECTION OF SPECIES REQUIREMENT

Our check in the amount of \$ - 0 - is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate of this sheet is enclosed.

Respectfully submitted,

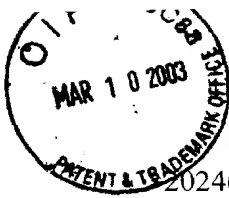
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: :
TOMOHIRO NAKAJIMA, ET AL : GROUP UNIT: 2876
SERIAL NO: 09/769,510 :
FILED: JANUARY 26, 2001 : EXAMINER: PAIK, S.
FOR: OPTICAL SCAN MODULE, :
OPTICAL SCANNER, OPTICAL :
SCAN METHOD, IMAGE...

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RESPONSE TO AN ELECTION OF SPECIES REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the communication dated February 10, 2003, and further in response to the Election of Species Requirement contained therein. Applicants herein provisionally elect the species listed as "Group I: Figures 1, 3, and 4, drawn to an optical scan module" in the Requirement and further list Claims 1-71 as readable thereon.

In addition, Applicants respectfully point out that the Election of Species Requirement is in error because it incorrectly states that Figures 22, 23, 25, and 26 are a "species" that must, by definition be mutually exclusive as to the asserted species listed as "Group I: Figures 1, 3, and 4, drawn to an optical scan module." In this regard, note again the following from MPEP §806.04(f):

Claims to be restricted to different species must be mutually exclusive. (Emphasis added.)

Rather than being mutually exclusive embodiments, these Figures share components.

Note, for example, that Fig. 1 illustrates scan module 101 that is covered by Claim 1, for

example. See the specification at page 15, lines 12-14, where Fig. 1 is described as showing the optical scan module 101. This scan module 101 is further illustrated as part of the Fig. 12 combination of scan modules described to be all the same at page 61, lines 1-7. Thus, Fig. 1 shows a subcombination part of Fig. 12 and these Figures cannot be said to be mutually exclusive. Just as Figs. 1 and 12 cannot be said to be mutually exclusive, neither can Figs. 1 and 22 be said to be mutually exclusive because Fig. 22 is described at page 83, lines 12-15 of the specification as including the “photo-sensitive body 150 comprised of a drum-shaped rotary member” that “has its peripheral surface, which constitutes the surface 105 to be scanned in Fig. 12, Fig. 14, Fig. 15, etc.”

Not only is the outstanding Election of Species Requirement in error in listing Figures 1 and 22 that both use module 101 as being drawn to separate and mutually exclusive embodiments, it further errs in failing to consider that the optical scanner modules are disclosed and claimed as being separate subcombinations (see Claims 1-71) and as being in combination with other elements to form the “image generator” of Claims 72-74 and “image reader” of Claims 75-77. In this regard, before the PTO can make a requirement to elect either the “optical scanner module” subcombination or the “image reader/generator” combination claims including the separately claimed optical scanning module subcombinations, it must, by directive of its own MPEP guidelines, establish distinctness under the appropriate one of MPEP sections 806.05(a)-806.05(i). See MPEP §806.04(b) requiring that distinctness must always be shown between inventions disclosed to be related, e g., a combination-subcombination relationship, even if it is asserted that such inventions are also species.

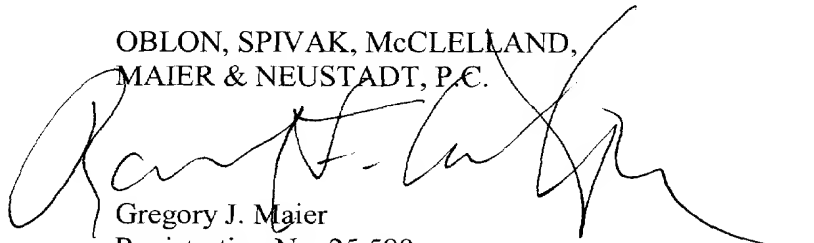
Moreover, combination Claims 72 and 75 recite the details of independent scanning module subcombination Claim 1, combination Claims 73 and 76 recite the details of

independent scanning module subcombination Claim 5, and combination Claims 74 and 77 recite the details of independent scanning module subcombination Claim 16 and that makes Claims 72-77 linking generic claims, contrary to the assertion of no generic claims in the outstanding Election of Species Requirement.

Accordingly, it is respectfully urged that this Election of Species Requirement should be withdrawn because of the above-noted errors and that an Action on the merits as to all of Claims 1-77 should be forthcoming.

Respectfully submitted,

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